

### REMARKS

In accordance with the foregoing, claims 1-10 and 12-14 are pending and claims 1 and 12 have been amended. No new matter is being presented.

Support for the amendment to claims 1 and 12 can be found in the specification at page 1, lines 10-15.

Claims 1-2, 4 and 14 are rejected under 35 USC 102(b) as being anticipated by Clark (U.S. Patent No. 4,966,644). This rejection is respectfully traversed.

As recited in the preamble of claim 1, the claimed apparatus is for separating multiple groups of sheets being output into separate groups. It follows from the preamble and the body of the claim that the apparatus separates multiple groups of sheets being output into separate groups. Clark fails to teach or suggest separating multiple groups of sheets being output into separate groups.

Further, claim 1 recites that "the marker and the feeder are formed as a pair of feeding means for positioning in contact with and/or separate from each other." In other words, the sheet and the marker are fed at the same time (see specification page 3, line 1). Further, there is no pause in the feeding of the sheets to add markers between the groups, thus saving time.

Clark does not teach that the sheet and the marker are fed at the same time. Clark discloses that the supply paper 13 is fed through rollers 70 and 71 after the photosensor 118 causes the control circuitry 110 to activate the supply paper roller motor 73 which rotates the supply paper advance roller 70 (col. 8, lines 38-41). Further, according to Clark, the advancement of the supply paper leading edge is stopped (col. 8, lines 47-48).

As stated above, an advantage of what is claimed in claim 1 is that the marker and sheets are fed at the same time and the apparatus does not stop. Thus, the features of claim 1 are not taught or suggested by Clark.

The Examiner stated that it is conventional to separate feed rollers from each other, synchronously with a cutter, when adherence is not occurring to prevent unnecessary feed and cutting of material and, thus, it would have been obvious to have provided in Clark that rollers 70 and 71 are separated when adherence is not needed, synchronously with cutter 39.

Thus, the Examiner admits that Clark does not disclose that the pair of feeding means is positioned in contacting each other when the marker is adhered to sheet and in separating each other when the adhering of the marker is not needed, as recited in claim 1. Therefore, as admitted by the Examiner claim 1 is not anticipated under 35 USC 102(b) by Clark and the rejection of claim 14 under 35 USC 102(b) is erroneous.

Further, even if the Examiner were to reject claim 1 under 35 USC 103(a), this rejection would be invalid because the Examiner has failed to provide any teaching in Clark or any other prior art reference which would have motivated one of ordinary skill in the art to have modified Clark as suggested by the Examiner. The Examiner is requested to cite a reference which supplies the necessary teaching or motivation to one of ordinary skill in the art, at the time of the invention, to modify Clark in the manner suggested.

Claims 2 and 4 are allowable at least due to their dependency from claim 1. Accordingly, it is respectfully requested that this rejection be withdrawn.

The rejection 5, 6 and 12-13, in view of Clark and other prior art references are respectfully traversed in light of the above remarks specifically pointing out that Clark does not

teach that which is asserted by the Examiner. Accordingly, it is respectfully requested that these rejections be withdrawn.

Claims 1-2, 4, 7-8 and 14 were rejected under 35 USC 103(a) as being unpatentable over Busk (U.S. Patent No. 3,245,859) in view of Lowe (U.S. Patent No. 3,926,713). This rejection is respectfully traversed.

As stated above, the present invention is directed toward separating multiple groups of sheets being output into separate groups. In contrast, Busk is directed to a tab assembly system for attaching a tab to the end of a sheet. Busk does not teach or suggest separating multiple sheets being output into separate groups.

Further neither Busk or Lowe teach or suggest that the marker and the feeder are formed as a pair of feeding means for positioning in contact with and/or separate from each other so that the sheet and the marker are fed at the same time, as claimed in claim 1.

Accordingly, for the reasons presented above with respect to the rejection in view of Clark, claim 1 is neither taught or suggested by Busk or Lowe, either alone or in combination. The remaining rejected claims are allowable at least due to their dependency on their respective dependencies. Claim 12 is allowable as it recites the same patentable features discussed above in connection with claim 1.

Since Busk does not teach or suggest that which the Examiner asserts, the remaining rejections are respectfully traversed.

It is respectfully requested that the foregoing amendments to the claims be entered in this Amendment under 37 CFR 1.116 since they do not require additional search or substantive consideration by the Examiner and are merely made to clarify that which has already been searched and considered previously.

Applicants respectfully submit that all of the pending claims are in condition for allowance, which action is requested.

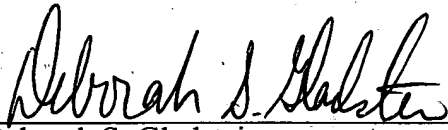
Attached hereto is a marked-up version of the changes made to the claims by this amendment, captioned "VERSION WITH MARKINGS TO SHOW CHANGES MADE."

In the event that the transmittal letter is separated from this document and the Patent and Trademark Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to Deposit Account No. 03-1952, referencing docket no. 163852016000. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Respectfully submitted,

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**VERSION WITH MARKINGS TO SHOW CHANGES MADE**

**In the Claims:**

Amend claims 1 and 12, as follows:

1. (Three Times Amended) A sheet sorting apparatus for adhering a marker to each predetermined sheet of a group of sheets being output by an image processing apparatus for separating multiple groups of sheets being output into separate groups, comprising:

a tape feeder for pulling out a tape having a pressure sensitive adhesive on one side edge;

a cutter for making the marker by cutting the tape at a preset length;

a guide for positioning the marker at a predetermined position on the predetermined sheet; and

a marker and sheet feeder for feeding the marker and the predetermined sheet in a partially overlapping position,

wherein the marker and the feeder [is] are formed as a pair of feeding means [positioned] for positioning in contact with and/or [separated] separate from each other,

the marker is adhered to the predetermined sheet by a predetermined pressure force as the predetermined sheet passes through the marker and sheet feeder, and

the pair of feeding means is positioned in contact with each other when the marker is adhered to sheet, and separated from each other when the adhering of the marker is not needed.

12. (Three Times Amended) An image processing apparatus comprising a sheet sorting apparatus for adhering a marker to each predetermined sheet of a group of sheets discharged from the image processing apparatus for separating multiple groups of sheets being output into separate groups, the sheet sorting apparatus comprising:

a tape feeder for pulling out a tape having a pressure sensitive adhesive on one side edge;  
a guide for positioning the marker at a predetermined position on the predetermined  
sheet; and

a marker and sheet feeder for feeding the marker and the predetermined sheet in a  
partially overlapping position,

wherein the marker and the feeder [is] are formed as a pair of feeding means for  
positioning in [contacting] contact with and/or [separating] separate from each other,

the marker is adhered to the predetermined sheet by a predetermined pressure force as the  
predetermined sheet passes through the marker and sheet feeder, and

the pair of feeding means is positioned in contacting each other when the marker is  
adhered to sheet and in separating each other when the adhering of the marker is not needed.